

REMARKS

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided, for the indication that the drawings are acceptable, for the acknowledgment of Applicants' Information Disclosure Statement by return of the Form PTO-1449, and for the acknowledgment of Applicants' Claim for Priority and receipt of the certified copy of the priority document in the Official Action.

Applicants acknowledge with appreciation the indication that claims 4-7 contain allowable subject matter on page 10 of the Official Action.

Upon entry of the above amendments, the specification will have been amended, claims 4, 6-11, 18 and 24 will have been amended, and claims 1-3 will have been canceled, without prejudice or disclaimer of the subject matter thereof. Claims 4-29 are currently pending. Claims 12-17, 20-23, 25, 26 and 29 have been withdrawn by the Examiner. Applicants respectfully request reconsideration of the outstanding objections and rejections, and allowance of all the claims pending in the present application.

On page 3 of the Official Action, the specification was objected to as containing minor informalities. Applicants note the specification has been amended to address the issues pointed out by the Examiner. Further, Applicants have reviewed the entire specification and determined that no other changes are necessary. Accordingly, Applicants respectfully request that the Examiner withdraw the objection to the specification.

On pages 4 and 5 of the Official Action, claims 18, 19 and 27 were rejected under 35 U.S.C. §112, second paragraph. Applicants note that claim 18 has been amended to depend from claim 12 (which has been withdrawn by the Examiner). Applicants submit that this amendment addresses the issues pointed out by the Examiner. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, second paragraph. Further, Applicants request that the Examiner indicate in the next Official Action whether claims 18, 19 and 27 should be considered withdrawn from consideration.

On page 4 of the Official Action, claims 9 and 19 were rejected under 35 U.S.C. §112, first paragraph.

In regard to claim 9, Applicants submit that the present application discloses erecting optical systems (having the disclosed light shield devices) which include semitransparent film on a first reflection surface. Note, for example, the discussion of semitransparent film formed on first reflection surface 13b at pages 20, 21, 25-27, and lines 7-14 of page 28.

As noted above, claim 18 (from which claim 19 depends) has been amended to depend from claim 12. Applicants submit that such amendment addresses the issue pointed out by the Examiner with respect to claim 19. In addition, Applicants direct the Examiner's attention to the embodiments shown in Figs. 26 and 27, as discussed at pages 34 and 35, which include beam splitting prisms 95 having semitransparent film 95a on an inclined surface, and a light shield on an exit surface 95b.

Accordingly, for at least the above noted reasons, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

On pages 5 and 6 of the Official Action, claims 1, 10 and 28 were rejected under 35 U.S.C. § 102(b). Applicants note that claim 1 has been canceled by the present amendment, and claims 10 and 28 now depend from claim 4, which the Examiner has indicated as including allowable subject matter. Therefore this rejection is deemed to be moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b).

On page 6 of the Official Action, claims 1 and 11 were rejected under 35 U.S.C. § 102(e). Applicants note that claim 1 has been canceled by the present amendment, and claim 11 now depend from claim 4, which the Examiner has indicated as including allowable subject matter. Therefore this rejection is deemed to be moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(e).

On pages 6 and 7 of the Official Action, claims 1-3 were rejected under 35 U.S.C. § 102(b). Applicants note that claims 1-3 have been canceled by the present amendment, therefore this rejection is deemed to be moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b).

On pages 7 and 8 of the Official Action, claims 1, 10, 18, 24, 27 and 28 were rejected under 35 U.S.C. § 103(a). Applicants note that claim 1 has been canceled by the present amendment, claims 10, 24 and 28 now depend from claim 4, which the Examiner has indicated as including allowable subject matter, and claims 18 and 27 now depend from claim 12, which the Examiner has withdrawn from consideration. Therefore this rejection is deemed to be moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

On pages 8 and 9 of the Official Action, claims 1-3, 8, 10, and 28 were rejected under 35 U.S.C. § 103(a). Applicants note that claims 1-3 have been canceled by the present amendment, and claims 10 and 28 now depend from claim 4, which the Examiner has indicated as including allowable subject matter. Therefore this rejection is deemed to be moot, at least with respect to these claims.

Applicants note that claim 8 has been amended to place it into independent form. Applicants submit that the subject matter of claim 8 would not have been obvious to one of ordinary skill in the art in view of the teachings of KANAI et al. (U.S. Patent No. 5,668,674) and Japan 10-39121.

Claim 8, as presently amended, includes, inter alia, "wherein said light shield device is formed by an extended portion of said erecting optical system on said incident surface thereof, said extended portion on said incident surface being deformed to extend toward said

objective lens side so that said off-field light bundle which is reflected by a first reflection surface of said erecting optical system is prevented from being incident on a second reflection surface of said erecting optical system and being allowed to exit from said erecting optical system via said extended portion."

Applicants submit that KANAI et al. lacks any disclosure of an extended portion on *an incident surface, extending toward the objective lens*. Applicant notes that the extension 13d disclosed in KANAI et al. is located at the exit surface of the erecting optical system. Further, the extension 13d (located at the exit surface) clearly does not *prevent a light bundle from being incident on a second reflection surface of the erecting optical system*. (Compare, for example, to Figs. 17 and 18 of the present application).

Applicants further submit that the Japanese document lacks any disclosure of an extended portion on an incident surface which *prevents a light bundle which is reflected by a first reflection surface from being incident on a second reflection surface, and being allowed to exit from the erecting optical system via such extended portion*.

Accordingly, Applicants submit that the combined teachings of such references could not possibly render as obvious the subject matter of claim 8. Applicants further submit that the modifications suggested by the Examiner are clearly the result of impermissible hindsight reasoning based upon the disclosure of the present application, rather than the teachings of the references themselves.

P21224.A05

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) for at least each, and certainly for all, of the above-noted reasons, and an early indication of the allowance of these claims.

Applicants note that claims 4, 6 and 7, which the Examiner indicated as including allowable subject matter, have each been amended to place them into independent form. Further, claim 9, which was not rejected based upon prior art, has also been amended to place it into independent form. Accordingly, Applicants respectfully request an early indication of the allowance of all of the pending claims.

COMMENTS ON REASONS FOR ALLOWANCE

In regard to the Examiner's indication of allowable subject matter in claims 4-7 on page 10 of the Official Action, Applicants do not disagree with the Examiner's indication that these claims are patentable with respect to the cited art based on various features of these claims. However, Applicants wish to make clear that the claims in the present application recite a combination of features, and that the patentability of these claims is also based on the totality of the features recited therein, which define over the prior art. Thus the reasons for allowance should not be limited to those mentioned by the Examiner.

SUMMARY AND CONCLUSION

Entry and consideration of the present amendment, reconsideration of the outstanding Official Action, and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so.

Any amendments to the claims that have been made in this amendment, which do not narrow the scope of the claims, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered cosmetic in nature, and to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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